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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: BURTON *et al.*  
Serial No.: 10/072,681  
Conf. No.: 2508  
  
Filed: February 8, 2002  
Allowed: December 3, 2003  
  
For: PURIFICATION OF NGF  
  
Art Unit: 1653  
Examiner: Abdel A. Mohamed  
  
Conf. No.: 2508  
Customer No.: 25213

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for Customer No. 25213

## PETITION TO CORRECT PATENT TERM ADJUSTMENT HISTORY UNDER 37 C.F.R. § 1.705(b)

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Commissioner for Patents  
US Patent and Trademark Office  
P.O. Box 1450  
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Dear Sir:

Applicants hereby submit a Petition pursuant to 37 C.F.R. § 1.705(b) for the correction of the calculation used to determine the Total Patent Term Adjustment and Applicant Delay (APPL) days at the time the above-captioned application was allowed on December 3, 2003. Applicants agree with the Total PTA Determination of "0" days, therefore, this concerns the calculations and the correct APPL Delay of record. The records in the PAIR/PALM system reflect a total Applicant Delay (APPL) of **232 days**. Applicants respectfully submit that, as described in detail below, the correct APPL delay for this application is **89 days**.

### REMARKS

A review of the Patent Term Adjustment History (PTA) in the PAIR system for this application shows that the U.S. Patent and Trademark Office (PTO) incorrectly calculated the "Applicant delay" for the Patent Term Adjustment.

USSN 10/072,681

L. Burt n

**PETITION TO CORRECT PATENT TERM ADJUSTMENT HISTORY**

A Final *Office Action* was mailed on August 19, 2003 regarding the rejection of the submission of an amendment of claim 1 and the entry of new claims 2-20. Applicants responded to the *Office Action* by Express mail on October 16, 2003. Thus, the response to the *Office Action* was received within three months of the mailing date. However, the returned date-stamped postcard indicates that the response was received by the USPTO on October 17, 2003, and the records in the PAIR/PALM system reflects the entry of "Amendment after Final Rejection" and "Terminal Disclaimer Filed" as received on October 17, 2003 when it was actually received on October 16, 2003. Thus, there is an error of one day in the APPL delay as calculated by the USPTO.

In response to rejections under the judicially-created doctrine of obviousness-type double patenting, after filing amendments and arguments on May 27, 2003 in opposition to that rejection, applicants filed a Terminal Disclaimer over U.S. Patent Nos. 5,423,831; 6,184,360; and 6,005,081 on October 16, 2003. The records in the PAIR/PALM system reflect that the APPL Delay clock started on May 27, 2003, and stopped on October 17, 2003 with the "Terminal Disclaimer Filed." However, Applicants believe that filing a *bona fide* response on May 27, 2003 should have been sufficient to stop the APPL Delay clock. Thus, Applicants are in disagreement with the calculation of the APPL Delay of **143 days** (from May 27, 2003 to October 17, 2003), for at least two reasons: 1) Applicants do not believe that the delay between the submission of amendments and arguments in opposition to the double patenting rejections and the filing of the Terminal Disclaimer should have resulted in an APPL Delay; 2) Even if the time after May 27, 2003 were to be counted (Applicants believe that this should not be counted as delay), the calculation is in error because the response was filed on October 16, 2003, not October 17, 2003.

True and correct copies of the following documents are attached:

- (1) Applicants' response to the *Office Action* mailed October 16, 2003 with the Customer Copy of the Express Mail label stamped by the US Post Office showing a mailing date of October 16, 2003;

**USSN 10/072,681**

**L. Burton**

**PETITION TO CORRECT PATENT TERM ADJUSTMENT HISTORY**

- (2) Applicants' response to the *Office Action* mailed October 16, 2003 with the returned date-stamped postcard showing receipt by the PTO on October 17, 2003.

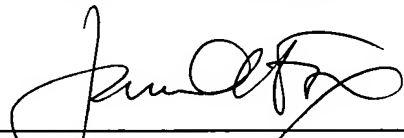
In accordance with Applicants' duty to ascertain that all portions of the Patent Term Adjustment determination are correct, Applicants respectfully request a correction to reflect Applicant Delay (APPL) as 89 days rather than 232 days in the U.S. Patent Office "File Contents History" and "Patent Term Adjustment History" records.

A check in the amount of \$200.00 for the PTA Petition fee set forth in 37 C.F.R. § 1.18(e) is enclosed. Any fee that may be due in connection with the filing of this paper may be charged to Deposit Account No. 08-1641.

Should there be any questions, please contact the undersigned at the correspondence address listed below. Thank you for your consideration.

Respectfully submitted,  
HELLER, EHRMAN, WHITE & McAULIFFE LLP

By:

  
\_\_\_\_\_  
James A. Fox  
Registration No. 38,455

Attorney Docket No. 39766-0037

**Address all correspondence to:**

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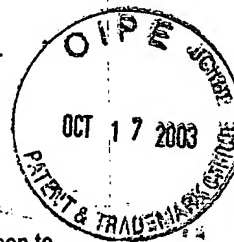


EXPRESS MAIL NO. FL 976 543 284 US -- DATE MAILED: October 16, 2003  
Attorney's Docket No. 39766-0037 C3 (JAF/cf)

Applicant(s): Louis E. BURTON, et al.  
Title: ISOLATION OF NEUROTROPHINS FROM A MIXTURE CONTAINING  
OTHER PROTEINS AND NEUROTROPHIN VARIANTS USING  
HYDROPHOBIC INTERACTION CHROMATOGRAPHY

Application Serial No. 10/072,681      Group Art Unit: 1653  
Filing Date: February 8, 2002      Examiner: Mohamed, Abdel A.

Commissioner for Patents -- MAIL STOP AF  
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SIR:

Please place the U.S. Patent and Trademark Office date stamp hereon to  
acknowledge receipt of the following:

1. Transmittal Form; Fee Transmittal; Terminal Disclaimer Under 37 C.F.R. §1.321(c) (2 pages);
2. Response to Final Office Action (6 pages); and Return Postcard.